

Te



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/499,069	02/04/2000	Ted Eugene Wright	77017.002	9708

7590 03/06/2002

ROBERT BERGSTROM  
BLACK LOWE & GRAHAM PLLC  
816 SECOND AVENUE  
SEATTLE, WA 98104

EXAMINER

CARTER, MONICA SMITH

ART UNIT	PAPER NUMBER
----------	--------------

3722

DATE MAILED: 03/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/499,069

Applicant(s)

WRIGHT, TED EUGENE

Examiner

Monica S. Carter

Art Unit

3722

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 February 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skelton ('611) in view of Cowan ('396) and further in view of Jacobs et al. ('737). Skelton discloses a single sheet form (23) (advertising medium for use in promoting hotels, restaurants, and the like (col. 1, lines 6-14)) comprising an unfolded form including a number of lines of perforations (44, 46, 48, 50, 52, 54, 56, and 58); the form including pre-printed textual and graphical information (col. 4, lines 53-65); the form being rectangular and having a greater vertical dimension than a horizontal dimension (col. 4, lines 28-35); and a lower tab (43) being separated from a central portion of the form by a horizontal line of perforations (45); wherein a packet is formed by folding the packet about the horizontal line of perforations and then about the vertical line of perforations.

Regarding the form being a key packet, in particular, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result

Art Unit: 3722

in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the form of Skelton is capable of performing the intended use of being a key packet, as claimed.

Regarding the packet including at most two lines of perforations that allow the unfolded packet to be quickly and accurately folded into a complete packet in two or fewer steps, Skelton discloses that the total preferable number of panels is none, however, "other total numbers of panels from three to eight may be utilized." (col. 4, lines 65-67).

Therefore, if three panels were to be used, there would be only two lines of perforations for folding the form into a complete packet. The operation would require only two steps of folding (for example, folding the left panel over the middle panel and then folding the right panel over the middle panel) for completing the packet.

Skelton discloses the claimed invention except for a registration form placed at the top portion of the form and separated from the form by a line of perforations.

Cowan discloses a form (12) having a tab portion (form) (22) extending from the top of the form (12) and separated from the form (12) by a line of perforations (54). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the packet of Skelton to include a detachable form at the top of the packet, as taught by Cowan, to provide an additional detachable flap for surrendering to someone for registration, ticketing, couponing, etc.

Regarding the form being a registration form, in particular, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed

Art Unit: 3722

invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the form (tab portion) of Skelton, as modified by Cowan, is capable of performing the intended use of being a registration form, as claimed.

Skelton, as modified by Cowan, discloses the claimed invention except for one or more die-cut slots in the unfolded packet for retaining a number of keys.

Jacobs et al. discloses a combined key holder and booklet having a die-cut slit (40) which is capable of retaining a hotel key. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the packet of Skelton to include a die-cut slit, as taught by Jacobs et al., to provide a retention means for items to be placed in the packet.

3. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Skelton in view of Cowan and Jacobs et al. and further in view of Zoland ('956).

Skelton, as modified by Cowan and Jacobs et al., discloses the claimed invention except for the key being selected from a group consisting of metal and magnetic key cards.

Zoland discloses a thin leaf suitable for use as a card or key carrying case for holding hotel keys wherein the keys may be an ordinary metallic key or a flat card key with a

Art Unit: 3722

magnetic stripe or other mechanism for encoding a key (col. 5, lines 9-22). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the packet of Skelton to include a magnetic key card for insertion into the pocket of the packet, as taught by Zoland, to provide an insert into the packet that may be used to obtain entry into a secure room and/or area.

### ***Response to Arguments***

4. Applicant's arguments filed February 01, 2002, have been fully considered but they are not persuasive. The Examiner maintains the rejections as set forth above. Applicant argues that Skelton fails to disclose die-cut slots, a detachable registration form, or a registration form and key packet. Skelton does disclose a single-sheet form that is capable of performing the intended use of being a registration form and key packet as set forth above. While Skelton does not disclose the use of die-cut slots, Jacobs teaches having die-cut slots in the cover of a booklet for carrying keys or the like. It is notoriously well-known in the art to provide die-cut slots in booklets for providing pockets. These pockets enable the booklet to easily hold inserts, keys, or other items that may be retrieved by the user. Modifying the packet of Skelton to include a die-cut slot would enable the packet to securely carry any number of items desired by the end user.

Applicant argues that Skelton discloses complex embodiments that require numerous folding operations. As disclosed in column 4, lines 65-67 of Skelton as few as three or

Art Unit: 3722

as many as nine panels may be used. Therefore, Skelton does disclose a less complex folding operation for the packet.

Applicant argues that Skelton's unfolded form is not rectangular and could not be fed through a laser printer. The Examiner disagrees. As seen in figure 1, Skelton fully discloses a number of rectangular panels that are joined by perforations providing a substantially rectangular form. A protruding flap (43) located adjacent one of the panels would not inhibit the form from being fed through a laser printer.

Applicant argues that Cowan fails to disclose quickly and accurately folding the key packet in two or fewer steps and Cowan employs fold lines rather than lines of perforations. It is noted that Cowan has been used for the teaching of locating the registration form along the top edge of the form and has not been relied upon for the teaching of folding the key packet along lines of perforations.

Applicant argues that Jacobs fails to disclose a simple folding operation and that Jacobs comprises multiple sheets instead of being a single-sheet form. It is noted that Jacobs has been used for the teaching of die-cut slots formed in a booklet for holding items and has not been relied upon for the teaching of simple folding operations nor a single-sheet form.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

Art Unit: 3722

the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Skelton, as modified by Cowan, Jacobs, and Zoland, fully discloses the claimed invention of a rectangular, single-sheet registration form and key packet as presently claimed and as set forth in the above rejections.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (8:00 AM - 5:30 PM).



Art Unit: 3722

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

mc

mc

March 5, 2002



A. L. WELLINGTON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700

**Attachment for PTO-948 (Rev. 03/01, or earlier)**  
**6/18/01**

**The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.**

**INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

**1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

**2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.